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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/518,791	08/21/2005	Edward J. Sare	07811.0020-00	8246

22852 7590 06/16/2009

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EXAMINER	
BRUNSMAN, DAVID M	

ART UNIT	PAPER NUMBER
1793	

MAIL DATE	DELIVERY MODE
06/16/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/518,791	SARE ET AL.	
	Examiner	Art Unit	
	David M. Brunsman	1793	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *3-5-2009*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-41* is/are pending in the application.

4a) Of the above claim(s) *13-16,18,19,21-36,39,40,42 and 43* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-12, 17, 20, 37, 38, 41, 44, 45* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claim(s) *1-41* are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

Applicant's election without traverse of group I, claims 1-12, 17, 20, 37, 38, 41, 44 and 45 in the reply filed on 12 September 2008 is acknowledged.

The rejection under 35 U.S.C. 112(1) is withdrawn in view of applicant's response

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 44 and 45 are rejected under 35 U.S.C. 102(b) as being anticipated by US 5393340.

Table VI of the patent discloses a number of calcined kaolin (metakaolin) products having an 80%/20% particle size distribution ration of 1.9-3.1 and having median particle size distributions that round to 1 micron.

Applicant's response argues that the claim term "about 1 micron" excludes the particle sizes of the reference. This argument is not persuasive. The preferred range of 0.66-0.79 microns in the reference falls within the scope of "about 1 micron." The term "1 micron" possesses only one significant figure and includes 0.50 to 1.4999999... . Furthermore, the term "about" allows further leeway as modifying "1". Applicant has not pointed to any evidence of record showing that one of ordinary skill in the art would consider 0.79 microns to be outside the scope of "about 1 micron:.

Figures 1 and 2 of the patent depict products according to the invention as plate-shaped particles, anticipating a shape factor of at least 10. US 6136086 is cited as

factual evidence that at least the Ansilex 93 example of Table VI has a oil absorption within the scope of the instant claims (105-120%). The similar disclosed uses as hiding pigments also suggests that the materials of the patent and those of the instant claims share characteristics.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-12, 17, 20, 37, 38 and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 5393340, as applied above, in view of US 6312511.

The difference between claims 37 and 38 and the primary reference is the source of the clay employed. Column 5, lines 20-26 of 6312511 teach that clays of the Rio Capim region has a number of particularly valuable properties. It would have been obvious to one of ordinary skill in the art to employ Rio Capim clay for that reason.

Independent claims 1 and 41 differ from the primary reference in that they limit the amount of alkali and alkaline earth metal to less than about 1.0%. As there is no recitation of removing alkali and alkaline earth from the Rio Capim clays, the evidence of record suggests that such clays naturally include less than about 1.0% alkali and

alkaline earth metals. As set forth above, it would have been obvious to one of ordinary skill in the art to employ Rio Capim clay and the limitation on the level of alkali and alkaline earth metals would flow naturally therefrom.

Claims 17 and 20 recite an intended future use of the claimed product and do not introduce limitations to the material itself that would take it outside the scope of the patent disclosure.

The difference between the prior art relied upon and claims 8-11 is the amount of mullite in the product. As the patent teaches that the process should be operated to avoid the formation of mullite and thereby avoid forming a more abrasive product, it is assumed that the product of the invention is substantially free of mullite. Column 2, lines 22-29 of the patent, however, do teach that fully calcining the kaolin to the mullite stage forms a product that is not just more abrasive but, also brighter. It would have been obvious to one of the level of ordinary skill in the art to balance the expected abrasiveness of the product to achieve an increased brightness because the patent teaches both the result of a more extensive calcination and the method by which it would be done.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David M. Brunsman whose telephone number is 571-272-1365. The examiner can normally be reached on M, Th, F, Sa; 7:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo can be reached on 571-272-1233. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/David M Brunsman/
Primary Examiner, Art Unit 1793

DMB